

REMARKS

I. Status of claims

Claims 34-55 are pending in this application. By this Amendment, claims 35 and 45 have been amended. Reconsideration is respectfully requested in view of the above Amendments and the following remarks.

Applicant respectfully submits that the Amendments to the claims introduce no new issues and simplify issues for Appeal and are thus may be properly entered after final rejection.

II. Elections/Restriction

The Office Action argues that “newly submitted” claims 45-55 are directed to an invention that is independent or distinct from the invention originally claimed because “the system of claim 34 is distinct from the system of claim 45”. This restriction requirement is respectfully traversed.

As set forth in 37 CFR. 1.142(b), the Examiner is required to provide a reason why the claims are patentably distinct. The Office Action provides no reason whatsoever why claims 45-55 are patentably distinct from original claims 34-44.

Even if the basis for restriction were correct, it would not constitute a legitimate basis for restriction. Claims 45-55 are amended claims that were not newly introduced. Previously presented claims 45-55 were already searched and examined and are not patentably distinct from currently pending claims 45-55.

Accordingly, the Examiner has not met the burden imposed by 37 CFR 1.142(b) and the restriction requirement is improper. Withdrawal of the restriction requirement is respectfully requested.

III. Claim Rejections

A. Rejection under 35 U.S.C. § 103(a) of claims 34-36 and 40-44

Claims 34-36 and 40-44 have been rejected under 35 U.S.C. § 103 over U.S. Patent No. 5,940,812 to Tengel et al. (hereinafter “Tengel”) in view of U.S. Patent No. 4,953,085 to Atkins, U.S. Patent No. 6,484,153 to Walker et al. (hereinafter “Walker”), Rutter, J. “Deals In Cyberspace” Euromoney, London, Feb. 1998 (hereinafter “Rutter”), and “Cyberstreet”, Wall Street and Technology, New York, June, 1997 (hereinafter “Cyberstreet”). This rejection is respectfully traversed.

Applicants respectfully submit that all of the references in combination would not have resulted in the invention of claim 34. The primary reference, Tengel, discloses a system for matching a loan with a potential borrower. The system disclosed by Tengel is a loan origination system. The functionality of the system is useful to borrowers and lenders from the time a borrower begins seeking a loan through the ultimate granting or denial of a borrower’s loan application. The Tengel system is not a client server-based loan management system for managing syndicate loans as required by claim 1 of the present application.

Tengel lacks many additional features required by presently pending claim 1. For example, Tengel fails to disclose a syndicate manager interface for accessing a loan management system over a communication network as required by claim 34. With respect this feature, the Office Action identifies reference numeral 111 as identifying a syndicate manager interface. However, reference numeral 111 points to a lender terminal, which is identical to the lender terminal 102, already identified in the Office Action as an investor interface. Applicants respectfully submit that Tengel makes no mention of syndicate loans or a syndicate manager interface.

In addition to lacking the syndicate manager interface and the client server-based loan management system for managing syndicate loans, Tengel lacks several other features required by pending claim 34. For example, as noted in the Office Action, Tengel further fails to show the following features: (1) a transaction management module for maintaining information corresponding to particular transactions; (2) a loan management module comprising a syndicate loan sub-module and a facility management sub-module, wherein the syndicate loan sub-module stores information corresponding to a plurality of different syndicate loans and the facility management module stores information corresponding to a plurality of different credit facilities, each credit facility corresponding to at least one syndicate loan and at least one borrower; and (3) a report module in communication with the loan management module, the transaction management module, the borrower management module and the investor management module.

Thus, the Office Action alleges that Atkins teaches feature (1) a transaction management module and feature (3) a report module, and that it would have been obvious to modify Tengel to include these features in order to receive, store, and monitor records for reporting.

Atkins discloses a personal financial management program. The program allows a client to specify financial objectives and risk preferences and suggests a portfolio to the client based on these selected preferences. The Office action alleges that it would have been obvious to include the transaction management module and report module of Atkins in the system of Tengel in order to store and monitor records of transactions.

However, the system of Tengel is directed to loan approval and does not involve transactions. Accordingly, no purpose would have been served by modifying Tengel to include a transaction management module. Tengel teaches away from incorporation of a transaction management module. A prior art reference must be considered in its entirety, i.e. as a whole,

there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

The modifications suggested would not improve or enhance the system of Tengel. If it would even be possible to incorporate these features as suggested, the incorporation would result in an entirely different system having functionality not contemplated by Tengel or any participants in the Tengel system.

In summary, The Office Action fails to establish a *prima facie* case of obviousness. Specifically, before considering what would be obvious to one of ordinary skill in the art at the time of the invention, the art must teach or suggest the claim limitations. See MPEP §2143. First, the combination of all references and teachings supplied by the Examiner fails to include several features of claims 34 as well as amended independent claim 45. Second, the modifications suggested would have been contrary to the objectives of Tengel and accordingly, no motivation would have been present to make the proposed combination..

Claims 35, 36, and 40-44 depend from claim 34 and therefore define over the art of record for at least the reasons set forth above with respect to claim 34.

B. Rejection under 35.U.S.C. §103(a) of claim 37

Claim 37 has been rejected under 35.U.S.C. §103(a) over Tengel in view of Atkins, Walker, Rutter, Cyberstreet, and in further view of U.S. Patent No 5,940,811 to Norris. This rejection is respectfully traversed. The additional references do not obviate the deficiencies of the references as set forth above. Withdrawal of the rejection is respectfully requested.

C. Rejection under 35.U.S.C. §103(a) of claim 38

Claim 38 has been rejected under 35.U.S.C. §103(a) over Tengel in view of Atkins, Walker, Rutter, Cyberstreet, and CFO Alert, "New Medium Brewing for Syndications",

including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir 1983).

Furthermore, with respect to the report module, as set forth in claim 34, the report module is in communication with the loan management module, the transaction management module, the borrower management module and the investor management module. As admitted in the Office Action, Tengel fails to disclose a transaction management module and a loan management module. Furthermore, the Office Action acknowledges that Atkins also lacks a loan management module. Thus, incorporation of a report module absent these features does not meet the limitations of claim 34.

With respect to feature (2), the Office Action alleges that Walker teaches a loan management module including several databases or sub-modules for different functions. The Office Action admits that Walker does not disclose syndicate loan sub-modules and facility management sub-modules. Instead, the Office Action relies on Rutter and Cyberstreet to teach management of syndicated loans and a database that stores information about syndicated deals respectively and argues that it would have been obvious to incorporate these features in the central processor of Tengel.

However, as set forth above, Tengel teaches away from the incorporation of such sub-modules, since the Tengel system is directed to a loan origination system and not a loan management system. The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then

hereinafter “CFO”. This rejection is respectfully traversed. The additional references do not obviate the deficiencies of the references as set forth above. Withdrawal of the rejection is respectfully requested.

D. Rejection under 35.U.S.C. §103(a) of claim 39

Claims 39 and 50 have been rejected under 35.U.S.C. §103(a) over Tengel in view of Atkins, Walker, Rutter, and Cyberstreet in further view of U.S. Patent No. 6,134,591 to Nickles. This rejection is respectfully traversed. The additional references do not obviate the deficiencies of the references as set forth above. Withdrawal of the rejection is respectfully requested.

IV. Claims 45-55

The Office Action has improperly restricted and withdrawn claims 45-55. This restriction and withdrawal have been traversed. Independent claim 45 includes the features of claim 35 as well as several additional features and therefore also defines over the art of record. Claims 46-55 depend from claim 45 and thus also define over the art of record for the reasons set forth above with respect to claim 45. Accordingly, the references fail to render the claims obvious and withdrawal of the rejection is respectfully requested.

V. Examiner’s Response to Arguments

Applicant notes that the argument that “the different labels attached to each of the interfaces are considered non-functional” did not appear in the non-final rejection. This may be interpreted as a new rejection not necessitated by Amendment. Because the Examiner deems these “labels” as “non-functional”, the Examiner has not given any weight to these limitations and has interpreted the invention as a plurality of interfaces for accessing a system over the network.

Not only is this argument newly presented, it is contrary to established law and procedure. First, the limitations of the presently pending claims cannot be considered to be nonfunctional. As set forth in MPEP 2106.01, "In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. The information in the claims clearly falls into the "functional" category. As set forth in MPEP 2106.01, non-functional descriptive matter applies to abstract ideas.

Secondly, even if the limitations in the presently pending claims were to be considered non-functional, examination procedure dictates that in order to render the claims obvious, all limitations in the claims must be contained within the prior art. If the Office Action is failing to give weight to all limitations apart from the system and interfaces,, Applicants respectfully traverse this interpretation of the 35 U.S.C. 103 because the interpretation is inconsistent with the law and with USPTO guidelines. During examination, every claim limitation must be addressed. USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983).

VI. Conclusion

As set forth above, applicant respectfully submits that all claims are in condition for allowance. Withdrawal of all rejections and prompt passage to issuance are earnestly requested. In the event Applicants have overlooked the need for an extension of time, payment of fee, or additional payment of fee, Applicants hereby petition therefore and authorize that any charges be made to Deposit Account No. 50-4494.

Should the Examiner have any questions regarding any of the above, the Examiner is respectfully requested to telephone the undersigned at 202-346-4016.

Respectfully submitted,

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